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10/552,288	10/03/2005	Andreas Winter	282595US8XPCT	2081
22850 7590 12/17/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER TRUVAN, LEYNN A THANH				
ART UNIT 2435		PAPER NUMBER		
NOTIFICATION DATE 12/17/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/552,288

Applicant(s)

WINTER ET AL.

Examiner

Leynna T. Truvan

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-15 are now pending.

Claim Objections

2. Claims 12-15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 12 is a computer program product which depends on method claim 1 and claim 13 which depends on claim 12 is computer readable storage means comprising a computer program product.

Claim 14 and claim 15 which depends on claim 14 is an optical data carrier, of which claim 14 depends on method claim 1.

Thus, claims 12-15 are improper because these claims for which they depend on are a method.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 12-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 12 recites a computer program product and claim 13 recites a computer readable storage means comprising a computer program product. Specification states computer program means adapted to perform the method steps [0056-0057]. Thus, the computer program product means is not supported which suggests the means is software. According to MPEP, these claims are directed to functional descriptive material since the descriptions and expressions of the programs are not physical things. Although, claim 13 includes a computer readable storage means is not enough to include statutory category until it specifies the non-transitory form of storage based on Nuijten case law.

Claims 14 and 15 recites an optical data carrier which is directed non-functional descriptive material that is recorded on electromagnetic carrier signal. Specification storing music, games, video are stored on optical storage carriers [0002] and where data is spied out from the signal [0004]. Hence, according to MPEP, this is not statutory since no requisite functionality is present to satisfy the practical application requirement

Therefore, claims 12-15 are not statutory.

MPEP 2106.01 [R-5] **> Computer-Related Nonstatutory Subject Matter<

****>**Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer

programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Dichr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

**I. FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES"
REPRESENTING DESCRIPTIVE MATERIAL PER SE OR COMPUTER
PROGRAMS REPRESENTING COMPUTER LISTINGS PER SE**

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. **Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.** In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Easley (US 5,548,784).

As per claim 1:

Easley discloses the method for protecting content within protected data areas on a target optical data carrier against unauthorized reading *and/or* copying with a computer, characterized by the steps of

determining whether a target optical data carrier ***or*** a non-target optical data carrier is inserted into a drive of the computer, and **(col.1, lines 19-47 and col.11, lines 1-6; *drive door or door open status is an indication and ability for a data carrier to be inserted.*)**

if a target optical data carrier is inserted into the drive of the computer modifying read requests to the protected data areas so that no data is read *or* the read data is useless, *and/or* modifying write commands in respect to the data within the protected data areas to a recordable data carrier *or* other storage so that the written data is useless. **(col.3, lines 20-35 and col.4, lines 9-27)**

The limitation "if" does not render the invention one sole affirmed carried out function/utility but a stipulation that only if the data carrier is inserted that the following functions is to follow. The claimed invention suggests the latter where the possibility of the target optical data carrier is not inserted into the drive of the computer. Then the limitation "modifying read requests to the protected data areas so that no data is read *or* the read data is useless, *and/or*

modifying write commands in respect to the data within the protected data areas to a recordable data carrier *or* other storage so that the written data is useless” is not carried out for these functions applies only if a target optical data carrier is inserted into the drive of the computer. Thus, prior art does not have to necessary read on the claimed “if a target optical data carrier is inserted into the drive of the computer” since the claimed also suggests the data carrier is not inserted. Which means the claimed invention may be only limiting “determining whether a target optical data carrier or a non-target optical data carrier is inserted into a drive of the computer”.

As per claim 2: See col.13, lines 29-45; discussing the method according to claim 1, characterized in that the modifying of read requests and/or of write commands is performed *only if* no authentication is available.

As per claim 3: See col.11, lines 10-31 and col.13, lines 45-55; discussing the method according to claim 1, characterized in that the determining and modifying steps are performed by routines implemented into a drive control layer within the computer.

As per claim 4: See col.12, lines 10-26 and col.17, lines 20-25; discussing the method according to claim 3, characterized in that the routines replace a dispatch routine and a completion routine, and have the functionality to perform the determining and modifying steps and to call the replaced dispatch and completion routines for their execution based on the original or modified read requests and/or write commands.

As per claim 5: See col.17, lines 15-30; discussing the method according to claim 3, characterized in that the routines are implemented by a driver that is installed by an executable that is automatically started when a target optical data carrier is inserted into the drive.

As per claim 6: See col.14, lines 45-55 and col.17, lines 15-30; discussing the method according to claim 5, characterized in that the driver gets is automatically loaded after each start of the computer, and/or does not comprise an unload routine, and/or changes its name randomly, and/or comprises filetimes that are set randomly, and/or comprises code that is changed randomly, and/or is installed multiple times, but is only one time active, and/or can be installed by installation programs spread all over the computer's system.

As per claim 7: See col.11, lines 58-67 and col.17, lines 15-40; discussing the method according to claim 5, characterized in that the driver comprises a communication interface to allow an exchange of control data and/or authentication data.

As per claim 8: See col.14, lines 45-55 and col.17, lines 15-45; discussing the method according claim 1, characterized in that a target optical carrier is distinguished from a non target optical data carrier by evaluating a predetermined session of the optical data carrier in respect to special modifications, and/or at least one of the tables of contents of the optical data carrier in respect to special entries, and/or a predetermined session of the

optical data carrier in respect to special subcode modifications, and/or predetermined data stored on the optical data carrier in respect to a watermark.

As per claim 9: See col.13, lines 29-45; discussing the method according claim 1, characterized in that a protected data area is identified on basis of a sector type, and/or a range of sectors, and/or sectors that are subject of specific read sequences.

As per claim 10: See col.13, lines 29-45 and col.17, lines 15-45; discussing the method claim 1, characterized in that a protected data area is defined by at least one predetermined area, and/or data stored on the optical data carrier itself.

As per claim 11: See col.7, lines 38-45 and col.17, lines 15-45; discussing the method according to claim 1, characterized in that the modifying of read requests so that the read data is useless, and/or the modifying of write commands so that the written data is useless comprises aborting a corresponding IO Request and/or IO Command with an error, and/or completing the corresponding IO Request and/or IO Command, but without processing the actual request and/or command, and/or modifying the respective data so that it is useless.

As per claim 12: See col.6, lines 22-67 and col.17, lines 15-25; discussing the computer program product, comprising computer program means adapted

to perform the method steps as defined in claim 1 when executed on a computer, digital signal processor, or the like.

As per claim 13: See col.17, lines 15-25; discussing the computer readable storage means, comprising a computer program product according to claim.

As per claim 14: See col.6, lines 22-67 and col.17, lines 15-30; discussing the optical data carrier, characterized by an executable program that is automatically started when the optical data carrier is inserted into the drive and that performs the method steps as defined in claim 1 when executed on a computer, digital signal processor, or the like.

As per claim 15: See col.6, lines 22-67 and col.17, lines 15-25; discussing the optical data carrier according to claim 14, characterized in that the executable program is arranged in a data session of a multi-session CD that also comprises an audio session.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leynna T. Truvan whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. T. T./
Examiner, Art Unit 2435
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435